UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DAVID S. RESNICK
100 SUMMER STREET
NIXON PEABODY LLP
BOSTON MA 02110-2131

In re Application of:	
LIEBERMAN, Judy, et al.	DECISION ON REQUEST UNDER
U.S. Application No.: 10/577,814	37 CFR 1.497(d)
PCT No.: PCT/US2004/036200	
International Filing Date: 01 November 2004	
Priority Date: 30 October 2003	
Attorney's Docket No.: 033393-055222-US	
For: METHODS FOR TREATING AND PREVENTING ISCHEMIA-REPERFUSION INJURY USING RNA INTERFERING AGENTS	

This decision is issued in response to the "Petition And Fee To Correct Inventorship Non-Provisional Application Under 37 CFR 1.48(a)" filed 03 May 2007, treated herein under 37 CFR 1.497(d).[1] Applicants will be charged the required $130 processing fee.

BACKGROUND

On 01 November 2004, applicants filed international application PCT/US2004/036200. The application claimed a priority date of 30 October 2003, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 30 April 2006. The published international application identified a corporate applicant for all states other than the U.S., and two applicant/inventors for the U.S.: Judy LIEBERMAN and Peter HAMAR.

On 28 April 2006, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 12 January 2007, applicants filed an executed declaration and the surcharge payment for filing the declaration later than thirty months after the priority date. The declaration included a third inventor who was not identified in the international application, Erwei SONG.

On 06 March 2007, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497. The Notification indicated that the

[1] 37 CFR 1.48(a) does not apply to national stage applications, such as the present case, which have not yet complied with the requirements of 35 U.S.C. 371(c); the applicable regulation is 37 CFR 1.497(d).

previously filed declaration was not acceptable under 37 CFR 1.497 because it included an inventor who was not listed on the international application.

On 03 May 2007, applicants filed a response to the Notification Of Missing Requirements that included the "Petition And Fee To Correct Inventorship Non-Provisional Application Under 37 CFR 1.48(a)" considered herein as a request under 37 CFR 1.497(d). The submission seeks to add Erwei SONG to the present application as an additional inventor.

DISCUSSION

Section 1893.01(e) of the MPEP states the following regarding changes in the inventorship of an international application entering the national stage (emphasis added):

> The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any changes effected under PCT Rule 92*bis*. See 37 CFR 1.41(a)(4). Accordingly, **an oath or declaration that names an inventive entity different than that set forth in the international application will not be accepted for purposes of entering the U.S. national phase unless the requirements under 37 CFR 1.497(d) are satisfied.** These requirements include: (A) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (B) the processing fee set forth in 37 CFR 1.17(i); and (C) the written consent of the assignee if an assignment has been executed by any of the original named inventors (see 37 CFR 3.73(b)).

As noted above, applicants have filed a declaration that includes a third inventor who was not identified as an inventor in the international application. Accordingly, applicants must satisfy the requirements of 37 CFR 1.497(d) before such declaration can be accepted.

Applicants here have provided the required statement from the person to be added as an inventor (Erwei SONG) stating that any error in inventorship in the international application occurred without deceptive intention on his part, and applicants have authorized a charge for required fees. Requirements (A) and (B) are therefore satisfied.

With respect to item (C) above, applicants have submitted a statement entitled "Consent Of Assignee Under 37 CFR 1.48(a)" that identifies "The CBR Institute for Biomedical Research" as the assignee of the entire interest in the present application, states that the assignee consents to the addition of Erwei SONG as an inventor, and is executed on behalf of the assignee by Ryan Dietz, identified thereon by the title "Office Of Technology Development." However, pursuant to 37 CFR 1.497(d)(3), the consent of the assignee must be submitted in compliance with 37 CFR 3.73(b) (see MPEP section 201.03(II)(D)). Here, the "Consent Of Assignee Under 37 CFR 1.48(a)" does not satisfy the requirements of 37 CFR 3.73(b)(1) and (2).

With respect to 37 CFR 3.73(b)(1), the assignee here does not expressly state that "the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation" or that "documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number)." With respect to 37 CFR 3.73(b)(2), the person signing the consent statement does not state that he is authorized to act on behalf of the assignee, nor is he identified with a title that confers him with apparent authority to act on behalf of the assignee (see MPEP section 324(V)). Because the assignee has not properly established ownership pursuant to 37 CFR 3.73(b), the statement of consent submitted here cannot, on the present record, be accepted in satisfaction of this requirement. Item (C) above is therefore not satisfied.

Based on the above, applicants have failed to submit all the requirements of a grantable request to correct the inventive entity pursuant to 37 CFR 1.497(d).

CONCLUSION

Applicants' request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

The inventorship of record herein remains that set forth in the international application, that is, Judy LIEBERMAN and Peter HAMAR. The declaration filed 12 January 2007 (and resubmitted with the present petition), which includes a third inventor, is therefore defective for failure to properly identify the inventors of record herein.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)" and must include the materials required to satisfy item (C) of a grantable request, as discussed above and in the MPEP, that is, the written consent of the assignee to the proposed change in inventorship, in the form required by 37 CFR 3.73(b).

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459